

REMARKS

The above referenced application has been reviewed in light of the Office Action mailed July 20, 2006. By the present amendment, Applicants have amended Claims 1, 14, 27 and 30. Applicants respectfully submit that the claims presently pending in the application, namely Claims 1-6, 14, 21 and 27-31, do not introduce new subject matter, are fully supported by the application and are patentable over the prior art of record. Claims 7-13, 15-20, 22-26, and 32 have been previously withdrawn in response to a Restriction/Election of Species Requirement dated June 2, 2006. Prompt and favorable reconsideration of the claims as presented and/or as amended herein is earnestly solicited.

Objection(s) to the Claims

In the Office Action, Claim 14 was objected to because "the resilient handle" lacked antecedent basis in Claim 1, the claim from which it depends. Applicants have amended Claim 14 to correct the antecedent basis for the recited term. Applicants respectfully request that the objection to Claim 14 be withdrawn.

Rejection(s) under 35 U.S.C. § 102(b) and § 103(a)

In the Office Action, Claims 1-6, 21, 27-28 and 30-31 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Application No. 2002/0151886 to Wood ("Wood"). Applicants respectfully submit that each of independent Claims 1, 21, 27 and 30, as

amended and/or presented herein, is allowable over Wood because Wood fails to anticipate and/or render obvious any of independent Claims 1, 21, 27 and 30.

Independent Claim 1 presently recites an electrosurgical pencil including, inter alia, a housing and an aspirating/irrigating system integrally formed with the housing. As seen throughout the figures of the present application, electrosurgical pencil 100 includes a housing 102 and an aspirating/irrigating system 140 operatively connected to and, more particularly, integrally formed with a proximal end of housing 102.

Conversely, Wood discloses an endoluminal radiofrequency cauterization system that includes, inter alia, a catheter 20, an electrode 28 supported within catheter 20, and a syringe 25 for the injection of liquid into the catheter via a tube (as seen in FIG. 1). Particularly, Wood discloses a catheter having “an injection port 23 that communicates with the hollow interior of catheter 20, and *may* receive a syringe 25 or the like for injection of liquid into the catheter.”(page 4, paragraph 42, *emphasis* added). Thus, the “aspirating/irrigating system” of Wood (i.e., syringe 25) is not integrally formed with the “housing”, e.g. catheter 20, but is a distinctly separate element.

Therefore, for the reason stated above, Wood fails to show, teach and/or suggest an electrosurgical pencil including, inter alia, a housing and an aspirating/irrigating system integrally formed with the housing, as called for in amended Claim 1. Accordingly, Applicants submit that in view of the amendments to Claim 1 and in view of the arguments presented above, that Claim 1 is not anticipated and/or rendered obvious by Wood.

Since Claims 2-6 and 14 depend from Claim 1, for at least the reasons stated above, Claims 2-6 and 14 are also not anticipated and/or rendered obvious by Wood.

Independent Claim 21 presently recites an electrosurgical pencil comprising, *inter alia*, a self-contained, manual aspirating/irrigating system. Also, as seen in the figures, electrosurgical pencil 100 includes manual aspirating/irrigating system 140 that is one unitary element, (i.e., self-contained).

As discussed above, Wood discloses an endoluminal radiofrequency cauterization system that includes, *inter alia*, a catheter 20 that *may* receive a syringe 25, for the injection of liquid into the catheter. As seen in FIG. 1, syringe 25 is completely separate from catheter 20. Thus, the “aspirating/irrigating system” of Wood is not self-contained.

Therefore, for the reason stated above, Wood fails to teach and/or suggest an electrosurgical pencil including, *inter alia*, a self-contained, manual aspirating/irrigating system, as called for in Claim 21. Accordingly, Applicants submit in view of the arguments presented above, that Claim 21 is not anticipated and/or rendered obvious by Wood.

Independent Claim 27 presently recites a method of aspirating/irrigating a target surgical site during an electrosurgical procedure including the step of providing an electrosurgical pencil having an aspirating/irrigating system, wherein the aspirating/irrigating system includes a resilient handle which is configured and adapted to deliver a quantity of fluid contained in the handle to a target surgical site when the handle is compressed and withdraw a quantity of fluid from the target surgical site when the handle is allowed to expand.

Independent Claim 30 presently recites an electrosurgical pencil comprising, *inter alia*, an aspirating/irrigating system including a resilient handle configured such that

compression of said handle causes the delivery of a quantity of fluid to a target surgical site and expansion of said handle to an uncompressed condition causes the withdrawal of a quantity of fluid from a target surgical site.

Although the Examiner states that "it is well known in the art that syringes are commonly made of plastic which is inherently resilient, and that the syringe of Wood is obviously, if not inherently resilient" (see page 3, line 22 to page 4, line 2, Office Action of July 20, 2006), Applicants respectfully disagree. As discussed above, Wood discloses an endoluminal radiofrequency cauterization system, which may include a syringe 25. While Applicants agree that syringe 25 may be constructed of plastic Applicants do not agree with the Examiners conclusion that the syringe is resilient because it is made of plastic. There are many plastics on the market that are "hard" plastics and, hence, not resilient.

Applicants respectfully submit that in order for the syringe 25 of Wood to properly function as a syringe disclosed therein, syringe 25 must be rigid and/or non-resilient. Otherwise, there would be no need for a plunger.

As recited in Claims 27 and 30, the resilient handle delivers a quantity of fluid when the handle is compressed and withdraws a quantity of fluid when the handle is allowed to expand. In the case of a syringe, such as syringe 25 of Wood, the body or cylinder of the syringe cannot itself be compressed in order to deliver fluid and cannot itself be allowed to expand in order to withdraw any quantity of fluid. A plunger including a stopper must be used in cooperation with the body or cylinder of the syringe to manually deliver or withdraw any fluid to or from the target surgical site. Thus, the

"aspirating/irrigating system" of Wood, i.e. syringe 25, does not include a resilient handle, as called for in each of Claims 27 and 30.

Therefore, for the reason stated above, Wood fails to teach and/or suggest a method of aspirating/irrigating a target surgical site during an electrosurgical procedure including the step of providing an electrosurgical pencil having an aspirating/irrigating system, wherein the aspirating/irrigating system includes a resilient handle which is configured and adapted to deliver a quantity of fluid contained in the handle to a target surgical site when the handle is compressed and withdraw a quantity of fluid from the target surgical site when the handle is allowed to expand, as called for in amended Claim 27.

Wood also fails to teach and/or suggest an electrosurgical pencil comprising, inter alia, an aspirating/irrigating system including a resilient handle configured such that compression of said handle causes the delivery of a quantity of fluid to a target surgical site and expansion of said handle to an uncompressed condition causes the withdrawal of a quantity of fluid from a target surgical site, as called for in amended Claim 30.

.Accordingly, Applicants submit that in view of the amendments to Claims 27 and 30 and in view of the arguments presented above, that Claims 27 and 30 are not anticipated and/or rendered obvious by Wood.

Since Claims 28 and 29 depend from Claim 27, and Claim 31 depends from Claim 30, for at least the reason stated above, Claims 28, 29 and 31 are also not anticipated and/or rendered obvious by Wood.

Rejection(s) under 35 U.S.C. § 103(a)

Additionally, in the Office Action, Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wood in view of U.S. Pat. No.6,352,544 to Spitz ("Spitz"). As noted above, Wood does not disclose or suggest all of the features of Claim 1, the base claim from which Claim 14 depends. The Examiner relies on Spitz for the proposition of the use of a rubber bulb or a syringe as an obvious interchange means for injecting fluid into a catheter lumen. However, Applicants submit that Spitz does not overcome the deficiencies of Wood, i.e., it does not provide any further disclosure or suggestion that, in combination with Wood, would render obvious the electrosurgical pencil of Claim 1. Since, Wood either taken alone or in combination with Spitz, suggests the elements of Claim 1, and since Claim 14 depends from Claim 1, for at least the reasons presented above, it is respectfully submitted that the rejection of Claim 14 should be withdrawn and that Claim 14 is in condition for allowance.

Additionally, in the Office action Claim 29 was rejected under 35 U.S.C. §103(a) as being unpatentable over Wood in view of U.S. Pat. No. 5,190,541 to Abele ("Abele"). As noted above, Wood does not disclose or suggest all of the steps of Claim 27, the base claim from which Claim 29 depends. The Examiner relies on Abele for the proposition of having an electrosurgical device with a separate suction syringe, in addition to a fluid delivery syringe, for cleaning and removing blood from the surgical area. However, Applicants submit that Abele does not overcome the deficiencies of Wood, i.e., it does not provide any further disclosure or suggestion that, in combination with Wood, would render obvious the electrosurgical pencil of Claim 27. Since, Wood either taken alone or in combination with Abele, suggests the elements of Claim 27, and

Appl. No. 10/716,776

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since Claim 29 depends from Claim 27, for at least the reasons presented above, it is respectfully submitted that the rejection of Claim 29 should be withdrawn and that Claim 29 is in condition for allowance.

Appl. No. 10/716,776
Amdt. Dated October 12, 2006
Reply to Office Action mailed July 20, 2006

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that Claims 1-6, 14, 21 and 27-31 are in proper format and are patentably distinct from the prior art of record and are in condition for allowance.

Should the Examiner believe that a telephone interview may facilitate prosecution of this application, the Examiner is respectfully requested to telephone Applicants' undersigned representative at the number indicated below.

Please charge any deficiency as well as any other fee(s) that may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s), to Deposit Account No. 21-0550.

Respectfully submitted.



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